Supreme Court, U.S.
FILED
OCT 14 1997
CLERK

No. 97-360

IN THE
Supreme Court of the United States
OCTOBER TERM, 1997

UNITED STATES SURGICAL CORPORATION,
Petitioner,
v.
ETHICON, INC. and
JOHNSON & JOHNSON HOSPITAL SERVICES, INC.,
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

REPLY TO BRIEF IN OPPOSITION

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14 pp

TABLE OF CONTENTS

	Page
TABLE OF AUTHORITIES	ii
ARGUMENT IN REPLY	1
A. Noncompliance With *Markman*	2
B. The Dictionary	7
CONCLUSION	9

TABLE OF AUTHORITIES

Cases: Page

Athletic Alternatives, Inc. v. *Prince Mfg., Inc.*, 73 F.3d 1573 (Fed. Cir. 1996) 6
Eastman Kodak Co. v. *Goodyear Tire & Rubber Co.*, 114 F.3d 1547 (Fed. Cir. 1997) 4
Exxon Chem. Patents, Inc. v. *Lubrizol Corp.*, 77 F.3d 450 (Fed. Cir. 1996) 4
Graham v. *John Deere Co.*, 383 U.S. 1 (1996) 6
J.T. Eaton & Co. v. *Atlantic Paste & Glue Co.*, 106 F.3d 1563 (Fed. Cir. 1997) 4
Kegel Co. v. *AMF Bowling, Inc.*, 1997 WL 574561 (Fed. Cir. 1997) 4
Litton Systems, Inc. v. *Honeywell Inc.*, 1995 U.S. Dist. Lexis 729 (C.D. Cal. 1995), *rev'd in part*, 87 F.3d 1559 (Fed. Cir. 1996), *vacated*, 117 S. Ct. 1240 (1997) 5
Lockwood v. *American Airlines, Inc.*, 107 F.3d 1565 (Fed. Cir. 1997) 4
Lough v. *Brunswick Corp.*, 103 F.3d 1517 (Fed. Cir. 1997) 4
Markman v. *Westview Instruments, Inc.*, 116 S. Ct. 1384 (1996) ..... 2, *passim*
In re Morris, 43 U.S.P.Q.2d 1753 (Fed. Cir. 1997) 4
Palestroni v. *Jacobs*, 10 N.J. Super. 266, 77 A.2d 183 (App. Div. 1950) 8
Regents v. *Oncor, Inc.*, 1997 U.S. Dist. Lexis 15068 (N.D. Cal. 1997) 2
State v. *Watson*, 261 N.J. Super. 169, 618 A.2d 367 (App. Div. 1992), *certif. denied*, 133 N.J. 441, 627 A.2d 1154 (1993) 8
Transco Prods., Inc. v. *Performance Contracting, Inc.*, 1997 WL 459771 (Fed. Cir. 1997) 6
United States v. *Old Chief*, 121 F.3d 448 (9th Cir. 1997) 8
United States v. *Weiss*, 752 F.2d 777 (2d Cir.), *cert. denied*, 474 U.S. 944 (1985) 7
Valmet Paper Machinery, Inc. v. *Beloit Corp.*, 105 F.3d 1409 (Fed. Cir. 1997) 4

TABLE OF AUTHORITIES—Continued

Page

Vitronics Corp. v. *Conceptronic, Inc.*, 90 F.3d 1576 (Fed. Cir. 1996) 9

Wright Med. Technology, Inc. v. *Osteonics Corp.*, 43 U.S.P.Q.2d 1837 (Fed. Cir. 1997) 4

Miscellaneous:

Brief for Appellees, *United States Surgical Corp.* v. *Ethicon, Inc.*, Nos. 94-1386 and 94-1219, U.S.C.A., Fed. Cir. (1994) 5

Brief in Opposition, *United States Surgical Corp.* v. *Ethicon, Inc.*, No. 94-2081 (1995) 2

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REPLY TO BRIEF IN OPPOSITION

Respondents scarcely attempt to defend the legal reasoning of the Court of Appeals on remand from this Court, or to reconcile it with this Court's decision in *Markman*. Nor do they deny the conflict among the Circuits and state courts on jury use of a dictionary.

Instead, respondents now try to label this case, in which this Court already has issued its mandate, as "unique." Br. Opp. 1, 6.[1] But it is in no way unique at all. On the contrary, this case is a paradigm of ordinary patent litigation: the plaintiff claims infringement; the defendant denies it, and asserts obviousness; the claims of the patent use many words familiar in everyday usage.

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[1] "Br. Opp." refers to respondents' Brief in Opposition; "Pet. Cert." to the Petition for Certiorari; "P.C.A." to the appendix to the Petition for Certiorari; and "C.A.A." to the appendix filed in the Court of Appeals.

Respondents' brief in opposition is almost wholly a paraphrase of the brief it filed opposing certiorari when this case was before this Court previously. *Compare* Br. Opp. 8-17 *with* Brief in Opposition, *United States Surgical Corp.* v. *Ethicon, Inc.*, No. 94-2081, at 10-18 (1995). This Court nevertheless granted certiorari, vacated the judgment, and remanded for application of *Markman* v. *Westview Instruments, Inc.*, 116 S. Ct. 1384 (1996). A. 71a-72a. *Markman* has not been applied.

A. Noncompliance With *Markman*.

1. The fundamental error of the District Court was to leave claim construction to be performed by the jury, instructing the jurors that "you must determine how the claims in this patent should be interpreted." P.C.A. 92a. Respondents argue, and the Court of Appeals agreed, that this plain violation of *Markman* did not matter because in some instances the claims might have been clear enough that the jury on its own might arrive at the same construction as a court. Br. Opp. 9. Hence the Court of Appeals' repeated excuse that the claims did not involve "technical terms" or "words of art." See P.C.A. 18a (three times), 19a, 31a, 35a.

But that misses the point of *Markman*. *Markman* contains no such exception. *Markman* held that the jury was not to be left to perform claim construction on its own even if a jury sometimes might construe correctly. That claims contain common words—like "inventory" in *Markman*—is no guarantee that a jury will construe them as a judge would. Nor is there any way to know what constructions the jury devises. The meanings of ordinary terms in context often are the hardest to agree upon. *Cf., e.g., Regents* v. *Oncor, Inc.*, 1997 U.S. Dist. Lexis 15068 at *8-*10 (N.D. Cal. 1997) (construing the word "a," referring to a dictionary, finally concluding that "the court must look to the patent specification and history").

And *Markman* explicitly covered construction of *all* terms of a patent claim, "*including*"—not, as the Court of Appeals would have it, limited to—"terms of art." *Markman*, 116 S. Ct. at 1387 (emphasis supplied).[2]

The fact that the jury, lacking any judicial construction, was allowed to turn instead to a dictionary—to consider which of several definitions, of how many words, no one can say—is irreconcilable with this Court's holdings not only in *Markman*, but in this very case. The violation cannot be erased by speculating that in the end, the jury perhaps arrived at claim constructions that were correct. The error was in leaving the jury, unrestricted by any judicial construction, to perform the task of claim construction itself. The Court of Appeals on remand simply perpetuated its earlier error, despite this Court's mandate.

2. Instead of even attempting to defend the Federal Circuit's holding that this Court's *Markman* decision is limited to "technical terms" and "words of art," respondents cite a handful of post-*Markman* cases which they say indicate that the limitations on *Markman* adopted in this case have not been applied in all Federal Circuit opinions. Br. Op. 10 n.1. Yet respondents themselves elsewhere characterize this case as

> "a determination by all of the judges of the Federal Circuit that the decision below is consistent with the controlling precedent of the *Markman* case."

Br. Opp. 7. And respondents apparently forget that this is not just another case among many seeking this Court's attention: rather, it is one in which this Court has already issued its mandate, and that mandate has not been followed.

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[2] Among the terms whose meaning was hotly disputed were "sequentially," "individually," "clip closing means," and "clip advancing means." These required construction in the context of words like "trocar," "cannula," "extending distally." See P.C.A. 8a-9a, 46a-50a, 76a, 79a-80a.

Moreover, the cases respondents cite, Br. Opp. 9, 10 n.1, do not contain any rejection by the Federal Circuit of the revision it gave *Markman* here. *In re Morris*, 43 U.S.P.Q.2d 1753 (Fed. Cir. 1997), for example, was an appeal from the Board of Patent Appeals that did not involve any trial or jury; and it characterized *Markman* as "readily distinguishable" because "*Markman* involved an infringement suit in the district court." 43 U.S.P.Q.2d at 1757.[3] Other recent opinions highlight the Federal Circuit's disagreements in applying *Markman*. See *J.T. Eaton & Co.* v. *Atlantic Paste & Glue Co.*, 106 F.3d 1563, 1577 (Fed. Cir. 1997) (Rader, J., dissenting) ("This decision stands as a monument at the troubled intersection between legal and factual analyses in this court's post-*Markman* jurisprudence . . . . Unfortunately, this court does not address the issue of obviousness directly, but instead distorts claim interpretation techniques . . . ."); *Lough* v. *Brunswick Corp.*, 103 F.3d 1517, 1519 (Fed. Cir. 1997) (Newman, J., dissenting) ("our court has cut another notch in the removal of patent issues from the trier of fact"); *Exxon Chem. Patents, Inc.* v. *Lubrizol Corp.*, 77 F.3d 450, 451 (Fed. Cir. 1996) (Mayer, J., concurring) ("This is another example of the predicted mischief of *Markman* . . . .)."

3. Respondents argue that petitioner cannot prove it was prejudiced by having the jury construe the claims. But certainly the prejudice is plain. First, with no construction supplied by the court, respondents were allowed

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[3] *Lockwood* v. *American Airlines, Inc.*, 107 F.3d 1565 (Fed. Cir. 1997), and *Kegel Co.* v. *AMF Bowling, Inc.*, 1997 WL 574561 (Fed. Cir. 1997), affirmed summary judgments that no jury issue existed. *Eastman Kodak Co.* v. *Goodyear Tire & Rubber Co.*, 114 F.3d 1547 (Fed. Cir. 1997), affirmed a district judge's construction without considering any issues raised here. Nor were any such issues raised or mentioned in *Valmet Paper Machinery, Inc.* v. *Beloit Corp.*, 105 F.3d 1409 (Fed. Cir. 1997), or *Wright Med. Technology, Inc.* v. *Osteonics Corp.*, 43 U.S.P.Q.2d 1837 (Fed. Cir. 1997).

to argue to the jury (as they continue to do here, Br. Opp. 2-3) that the patent claims were so broad as to be obvious —for example, that the claims would cover "any jaws." See Pet. Cert. 14 & n.12.[4] Second, even if in spite of such arguments a jury might arrive at a construction resembling what a court would conclude, nothing prevented the jury, uninstructed as to what the claims meant, and therefore uncabined, from coming up with a different construction of its own. That this jury did not consider claim interpretation simple is confirmed by its request for and use of a dictionary. The *Markman* violation, and the prejudice, was in failing to instruct the jury as to what the claims meant, and instead leaving the jury to give them its own construction—what construction, the record does not reveal.

Respondents also rehearse in this Court their jury argument about supposed concessions by one witness, as if their (mis)characterization of the evidence could make the issue of claim construction, and this Court's mandate, disappear. Br. Opp. 2. Quite different was respondents' characterization of the record to the Court of Appeals: that "[t]here was a sharp dispute at trial on how a person of ordinary skill in the art would construe the claims." Brief for Appellees, Nos. 94-1386 and 94-1219, U.S.C.A., Fed. Cir., at 28 (1994). Indeed, respondents acknowledged below that the parties' competing construc-

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[4] Such expansive claim interpretations are typically asserted as part of obviousness defenses. *Cf., e.g., Litton Systems, Inc.* v. *Honeywell Inc.*, 1995 U.S. Dist. Lexis 729 (C.D. Cal. 1995), *rev'd in part*, 87 F.3d 1559 (Fed. Cir. 1996), *vacated*, 117 S. Ct. 1240 (1997):

> "Here, the central claim interpretation dispute is with respect to the meaning of the term 'Kaufman-type ion beam source' . . . . Litton argues that the term means 'any broad beam gridded ion beam source' . . . . Honeywell's position is that the term means a broad beam ion gun that has (1) a hot wire cathode; (2) an anode; (3) magnets; and (4) grids . . . ."

1995 U.S. Dist. Lexis 729 at *123-*124.

tions "could not have been more divergent." *Id.* at 29. The District Court itself pointed out that "the parties intensely disputed the meaning of the claims." P.C.A. 61a.

Finally, because no one can know what claim construction the jury adopted, meaningful appellate review of that legal issue was denied. The Court of Appeals never adopted for itself respondents' jury argument that the claims had to be given a vastly broad construction. To have done so would have contradicted a fundamental rule of patent law—when *judges* apply it—that "if two equally plausible claim interpretations exist, the claim should be construed narrowly." *Transco Prods., Inc.* v. *Performance Contracting, Inc.*, 1997 WL 459771 at *4 (Fed. Cir. 1997).[5]

Instead, the Court of Appeals, without ever construing the claims, held it was enough that the record contained "substantial evidence" to support a construction by the jury that the claims were so broad as to be obvious. P.C.A. 36a. But "substantial evidence" cannot sustain a verdict of a jury that was not properly instructed. This Court did not vacate and remand with instructions to look for "substantial evidence." It remanded for the judge as required in *Markman*, not the jury, to construe the patent claims. To this day, in spite of this Court's remand, *Markman* has never been applied, and these claims have never been judicially construed at all.

4. Respondents concede that under this Court's decision in *Graham* v. *John Deere Co.*, 383 U.S. 1 (1966),

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[5] "Where there is an equal choice between a broader and a narrower meaning of a claim, and there is an enabling disclosure that indicates that the applicant is at least entitled to a claim having the narrower meaning, we consider the notice function of the claim to be best served by adopting the narrower meaning."

Id., quoting *Athletic Alternatives, Inc.* v. *Prince Mfg., Inc.*, 73 F.3d 1573, 1581 (Fed. Cir. 1996).

the factors on which an obviousness determination depends include "the differences between the prior art and *the claimed invention*." Br. Opp. 3 (emphasis supplied), citing 383 U.S. at 17. Construing "the claimed invention" thus is an essential step in an obviousness determination as well as in an infringement claim.

Nor do respondents ever address the anomaly that would arise, see Pet. Cert. 15, if assertions that patent claims were obvious were to be exempted from *Markman*: because most patent cases (like this one) include both infringement and obviousness issues, the decision here would leave the same claims to be construed by the judge for one issue, but by the jury for the other.

B. The Dictionary.

5. Respondents are unable to deny the present decision's split with five Circuits and at least seven states, all of which hold that jury use of a dictionary is reversible error unless established to be harmless. See Pet. Cert. 17-22. The only decision respondents seriously attempt to distinguish is the Second Circuit's holding in *United States* v. *Weiss*, 752 F.2d 777 (2d Cir.), *cert. denied*, 474 U.S. 944 (1985), that reversal is required unless there is "an affirmative showing . . . that the information was harmless." 752 F.2d at 783. That case is different, respondents say, because it involved an accounting textbook rather than a dictionary. Br. Opp. 14. They also say that "*Weiss* did not require the trial court to hold an evidentiary hearing," Br. Op. 14; that is an odd comment, given that *Weiss* emphasized that the trial court already had held what the Second Circuit approved as "an exhaustive evidentiary hearing." 752 F.2d at 783. Here, of course, there was no hearing at all, because the trial judge saw no problem. Finally, respondents seek comfort in observing that in *Weiss* "the jury obtained [the book] on its own without the trial court's imprimatur," whereas here it "was provided to the jury by the trial court on notice to both parties." Br.

Opp. 14. Exactly so. Here with the Federal Circuit's approval the trial judge, over objection of both parties, gave its "imprimatur" to, and was complicit in, what other Circuits unhesitatingly treat as jury misconduct.[6]

6. Respondents' assertion that the late Justice Brennan's much-cited opinion in *Palestroni* v. *Jacobs*, 10 N.J. Super. 266, 271, 77 A.2d 183, 185 (App. Div. 1950), "apparently is no longer the law in New Jersey," Br. Opp. 15, is the sheerest wishful fancy on respondents' part. They cite *State* v. *Watson*, 261 N.J. Super. 169, 618 A.2d 367 (App. Div. 1992), *certif. denied*, 133 N.J. 441, 627 A.2d 1145 (1993). But that case in no way questioned the *Palestroni* rule at all. In fact, it reiterated that juror resort to dictionaries is not tolerated:

> "During jury deliberations a juror brought a dictionary into the jury room. When it came to the trial judge's attention, *she immediately caused it to be removed* and *instructed the jury not to refer to it* and to rely only on her charge. *There was no objection* by defense counsel. There is nothing in the record to show that the dictionary was used nor, if it was, what use was made of it. We are satisfied that the presence of the dictionary in the jury room was incapable of producing an unjust result."

Watson, 261 N.J. Super. at 181, 618 A.2d at 373 (emphasis supplied). Thus, far from abandoning Justice Brennan's condemnation of juror use of dictionaries, *Watson* underscored it, affirming only because the circumstances were vastly different from those in this case:

> —There, a juror brought a dictionary. Here, the trial judge himself provided it.

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[6] The cases respondents cite at Br. Opp. 13 n.2 involved charges of juror misconduct in general, not dictionaries. *E.g.*, *United States* v. *Old Chief*, 121 F.3d 448, 451 (9th Cir. 1997) (juror's question to judge and juror's whispering). None affects at all the conflict with other Circuits and state courts described at Pet. Cert. 17-22.

—There, no objection was made until the appeal. Here, *both sides objected,* but the trial judge sent the jury a dictionary anyway. C.A.A. 686, A. 67a.

—There, the dictionary was removed "immediately," as soon as the judge learned of its presence. Here, the dictionary remained for days, throughout deliberations, and was furnished in response to the jury's expressed intention to use it.

7. Respondents say that "[i]t bears emphasizing" that "the Federal Circuit often relies upon dictionary definitions when it construes non-technical terms in patent claims." Br. Opp. 16 n.4 (citing cases and referring to "more than 400" others). But that is exactly the point. Dictionaries are for *courts* to consult in construing *legal* texts. They are not proper extra-record evidence for juries to peruse indiscriminately. See Pet. Cert. 16 (citing examples of dictionary use by this Court in interpreting legal texts). Judges explain which definitions they deem pertinent, and why. Moreover, when judges consult dictionaries in construing patent claims, they do so only "so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents." *Vitronics Corp.* v. *Conceptronic, Inc.*, 90 F.3d 1576, 1584 n.6 (Fed. Cir. 1996).

CONCLUSION

For the reasons stated, the judgment should be vacated and the case remanded with instructions to order a new trial in which claims are judicially construed as required by *Markman.* Alternatively, certiorari should be granted and the case set for argument.

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